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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,598	11/24/2003	Robert Reynolds	BSC-188C1	5007
22852	7590	12/03/2008		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER EIDE, HEIDI MARIE	
			ART UNIT	PAPER NUMBER
			3732	
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			12/03/2008 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/720,598

Applicant(s)

REYNOLDS ET AL.

Examiner

Heidi M. Eide

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-41, 43-45, 47-51 and 57-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38-41, 43-45, 47-51 and 57-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 27, 2008 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 38, 47-49, 51, 58-61 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ouchi et al. 6,077,274 (Ouchi).

2. Ouchi discloses a medical device comprising a sheath 30 comprising a proximal end and a distal end, a handle at the proximal end of the sheath (col. 3, ll. 18-20), a basket having a collapsed position when the basket is within the sheath and an expanded position when the basket is positioned beyond the distal end of the sheath and expended (col. 3, ll. 22-30), the basket comprising a plurality of wires 1, which comprise stainless steel (col. 2, ll. 65-67), a proximal end, and a distal end where the distal ends of the plurality of wires are joined at a joint (col. 3, ll. 3-9). Ouchi further

discloses the basket distal end comprises a tip member 20 sealed at the distal end as illustrated in fig. 2, the tip member is tubular and comprises a proximal end, a distal end, and a lumen extending at least partially therethrough, the lumen of the tubular tip member is adapted to receive an end of the basket wires therein and the basket distal end comprises a solder joint (col. 3, ll. 3-6). Ouchi does not specifically teach the joint at the distal end of the basket is configured to fail when a first predetermined force is applied to the joint, the distal ends of the plurality of wires releasing from each other when the joint fails, the first predetermined force being less than a force required to cause one of the plurality of wires or the proximal end of the basket to fail, however, Ouchi teaches the tip is fixed by silver soldering and the wires are of stainless steel (col. 2, ll. 66-67, col. 3, ll. 3-5). On page 12, lines 3-7, of the applicant's own specification, the applicant discusses the tip being manufactured of silver, a softer alloy, which results in the tip releasing from the basket wires. Therefore the apparatus taught by Ouchi would function as claimed since the wires are made of stainless steel, like the present invention, and the tip is silver soldered, as discussed above. As to claims 58 and 60, Ouchi also does not specifically teach the distal joint applies a retention force of the plurality of wires, the plurality of wires applies a tension force of the distal joint when force is applied to the basket and the tension force exceeds the retention force when the force applied to the basket exceeds the first predetermined force, however, as discussed above, Ouchi teaches the apparatus as claimed which is capable of functioning as claimed, therefore the claimed limitations are met.

3. Claims 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ouchi et al. 6,077,274 (Ouchi) as applied to claim 38 above, and further in view of Okada et al. 5,059,199 (Okada). Ouchi teaches the invention as discussed above, however, does not teach each of the plurality of wires comprises four bends and the basket in the expanded position is wider at the distal end than at the proximal end. Okada teaches each of the wires comprises four bends and the basket in the expanded position is wider at the distal end than at the proximal end as illustrated in fig. 1. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Ouchi in view of Okada since the modification would have involved a mere change in shape and it has been held the mere changes in shape involve routine skill in the art (*In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) MPEP 2144.04 IV B).

4. Claims 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ouchi et al. 6,077,274 (Ouchi) as applied to claim 38 above, and further in view of Bates 5,944,728. Ouchi teaches the invention as discussed above, however, does not teach the distal end of at least one wire is scored and wherein the cross section of at least one of the plurality of wires is D-shaped or V-shaped. Bates teaches the "inner surface of the legs can comprise a surface that is rougher than the outer surface, and this roughness can comprise, for example, a serrated surface, a toothed surface of an etched surface" (see col. 2, lines 35-38). An etched surface is considered to be scored. It would have been obvious to one having ordinary skill in the art at the time the

invention was made to score at least one wire or leg of the basket as taught by Bates in order to enhance stone capture and retention. Bates further teaches the cross section of at least one of the plurality of wires is D-shaped or V-shaped (col. 5, ll. 49-54). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Ouchi in view of Bates since it has been held that the configuration of the claimed wire was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed wire was significant (*In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) MPEP 2144.04 IV B).

5. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ouchi et al. 6,077,274 (Ouchi) as applied to claim 38 above, and further in view of Bates et al. 5,792,145 (Bates). Ouchi teaches the invention as discussed above, however, does not teach the distal end of the tip member is spherico-conical shape. Bates teaches the distal end of the tip member is spherico-conical shape as illustrated in fig 2. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to change the shape of the tip since it has been held that the configuration of the claimed tip was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed tip was significant (*In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) MPEP 2144.04 IV B).

6. Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ouchi et al. 6,077,274 (Ouchi) as applied to claim 38 above, and further in view of Bates 5,935,139. Ouchi teaches the invention as discussed above, however, does not specifically teach the handle is detachable. Bates teaches a similar expandable device with removeable handles (col. 6, ll. 54-57). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the handles detachable as taught by Bates in order to make the device more versatile for the user.

7. Claims 62-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ouchi et al. 6,077,274 (Ouchi) as applied to claim 59 above, and further in view of Mazzocchi et al. 6,605,102 (Mazzocchi). Ouchi teaches the invention as discussed above, however, does not specifically teach the tip member exerts a pressure on the respective distal ends of the plurality of wires, the tip member being the clamp, disposed within the lumen to retain the wires within the lumen. Mazzocchi teaches the tip member exerts a pressure on the respective distal ends of the plurality of wires disposed within the lumen to retain the wires within the lumen (col. 13, ll. 10-16). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Ouchi in view of Mazzocchi as a matter of obvious design choice since Mazzocchi also teaches soldering (col. 13, ll. 10-16), as a method of attaching the wires to the lumen. As to claim 63, Ouchi also does not specifically teach the distal joint applies a retention force of the plurality of wires, the plurality of wires applies a tension force of the distal joint when force is applied to the basket and the tension force exceeds

the retention force when the force applied to the basket exceeds the first predetermined force, however, as discussed above, Ouchi teaches the apparatus as claimed which is capable of functioning as claimed, therefore the claimed limitations are met. As to claim 64, Ouchi teaches the invention as discussed above, however, does not specifically teach the wires are configured to fail when a first predetermined force is applied to the basket and wherein the tip member is configured to fail when a second predetermined force is applied to the basket, the second predetermined force being less than the first predetermined force, however, the apparatus is taught as claimed which is therefore capable of functioning as claimed, therefore the claimed limitations are met.

8. Claims 45 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ouchi et al. 6,077,274 (Ouchi). As to claim 45, Ouchi discloses the claimed invention as discussed above, however, does not teach the radial stiffness of at least one wire is greater than 0.7 g/mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use wires with a stiffness value that would render the wires capable of retrieving stones including a value greater than 0.7g/mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. As to claim 65, Ouchi teaches a sheath 30 comprising a proximal end and a distal end, a handle at the proximal end of the sheath (col. 3, ll. 18-20), a basket having a collapsed position when the basket is within the sheath and an expanded position when the basket is positioned beyond the

distal end of the sheath and expended (col. 3, ll. 22-30), the basket comprising a plurality of wires 1, a proximal end, and a distal end where the distal ends of the plurality of wires are joined at a joint (col. 3, ll. 3-9). Ouchi teaches the distal end comprising a solder joint (col. 3, ll. 3-5) but does not teach the distal end comprises an over-molding joint. However, in par. 51, of the applicant's own specification, the applicant states that various method of joining wires are known in the art including solder and overmolding. Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention any known method joining wires as an obvious matter of design choice. Ouchi does not teach the distal ends of the plurality of wires releasing from each other when a predetermined force applied to the basket is less than a force required to cause one of the plurality of wires or proximal end of the basket to fail, however, Ouchi teaches the invention as discussed above which is capable of functioning as claimed, therefore the claimed limitations are met.

Response to Arguments

Applicant's arguments with respect to claims 38-45, 47-51 and 58-66 have been considered but are moot in view of the new ground(s) of rejection. As discussed above, the applicant teaches in their own specification the wires are made of stainless steel and the tip is made of a softer alloy, including silver, and this causes the tip to be released from the wires. Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention that the silver soldered tip of the invention taught by Ouchi would fail before the stainless steel wires.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 38, 47-51 and 57-66 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 5-11, 18, 42-4346, 48-52 and 60 of U.S. Patent No. 6,673,080. Although the conflicting claims are not identical, the present application is adding features not presented from the parent application, and there is no reason why applicant would be prevented from presenting claims corresponding to the instant application in the parent case. Furthermore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the present invention in view of Ouchi, to teach the sheath and handle, in order to operate the basket to perform the surgical procedure.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heidi M. Eide whose telephone number is (571)270-3081. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on 571-272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Heidi Eide
Examiner
Art Unit 3732

/Heidi M Eide/
Examiner, Art Unit 3732

11/18/08

/Cris L. Rodriguez/
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